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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,651	12/22/2000	Eugene J. Rollins	50269-0512	9835
29315	7590	10/03/2003	EXAMINER	
MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO PC 12010 SUNSET HILLS ROAD SUITE 900 RESTON, VA 20190			KYLE, MICHAEL J	
			ART UNIT	PAPER NUMBER
			3676	

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/747,651

Applicant(s)

ROLLINS ET AL.

Examiner

Michael J Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 4, 6, 8-10, 12-16, 18, 20, 22-24, and 26-29, are rejected under 35

U.S.C. 102(e) as being anticipated by Markus (U.S. Patent No. 6,499,042).

3. With respect to claims 1, 2, 4, 6, 15, 16, 18, and 20, Markus discloses a method wherein the method comprises the computer implemented step of receiving a request from a user for an electronic document (17), retrieving information associated with the user (from 27), generating an updated electronic document (by filling in the blank fields) and providing the updated electronic document to the user. Markus also discloses an optional step of receiving validation data from the user, and validating the validation data (column 3, lines 30-32). Markus discloses storing information via a cookie (Abstract). The electronic document is a web page, and the updated electronic document is a web page generated by an integrated order mechanism.

4. With respect to claims 8-10 and 22-24, Markus discloses the information associated with the user to be retrieved via a post from a server. The examiner considers the contacting of the Selective Proxy to be a post from a server. Markus also discloses the request from the user to be received at an intermediary (URL), wherein the electronic document is stored on a server (document server), wherein the retrieving the electronic document comprises the steps of sending

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a new request from the intermediary to the server, and receiving at the intermediary, the electronic document from the server. Markus also discloses the information associated with a user to be retrieved from a wallet server. The user information in Markus is retrieved from the selective proxy. Because the selective proxy contains personal information, the examiner considers it a wallet server.

5. With respect to claims 12-14 and 26-28, Markus discloses the step of generating the electronic document to comprise generating the updated electronic document by updating one or more data fields based upon information associated with the user. Markus also determines whether one or more variables included in the electronic document include valid user data and revises the electronic document by substituting one or more data values from the user information. Examiner asserts that a blank field is not valid user data. Markus fills blank fields with valid user data. Furthermore, Markus determines whether one or more variables in the electronic document correspond to at least one of a plurality of data values, when one or more variable does not correspond, Markus examines the context in which each of the variables is used, identifies a particular data value from the plurality of data values, and substitutes the particular data value.

6. With respect to claim 29, Markus discloses an intermediary (selective proxy), and a server that is associated with an electronic document (document server) wherein the intermediary retrieves the electronic document from the server and information associated with the user and generates an updated electronic document.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markus in view of Markus et al (U.S. Patent No. 6,490,601). From hereon, Markus (US 6,499,042) will be referred to as Markus '042, and Markus et al (US 6,490,601) will be referred to as Markus '601. While Markus '042 suggests that storing information associated with the user may be used with one or more other electronic documents, it is not specifically disclosed.

9. Markus '601 teaches that stored user information may be used with one or more other electronic documents. This allows the user information to be automatically filled in forms from a plurality of websites that are affiliate members of the service (column 7, line 63 – column 8, line 12). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Markus '042 so that the user information may be used with one or more other electronic documents, so that the user only has to register information at one central location.

10. Claims 5, 11, 19, 25, are rejected under 35 U.S.C. 103(a) as being unpatentable over Markus in view of Wong et al (U.S. Patent No. 5,956,699). Markus discloses personal information to be stored in a cookie. Because this cookie stores personal information, the examiner considers it a wallet cookie. However, Markus fails to disclose the information to be stored in an encrypted format.

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11. Wong et al teaches a secure system for transactions where the user may encrypt their personal information that is stored on a server so as to limit access to their personal information. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to encrypt the stored user information of Markus as taught by Wong et al, so as to limit, and prevent access to the user's personal information.

12. Claims 7 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markus in view of Rhoads (U.S. Patent No. 6,285,776). Markus fails to disclose the user information to be retrieved via the use of a tracer image.

13. Rhoads teaches the use of a tracer image to identify a specific article can be identified through use of a detecting apparatus. This makes identifying marks difficult for unauthorized persons to recognize without proper equipment. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Markus by including a tracer image to identify a user, and retrieve the associated user information, so as to provide discrete way of identifying the user.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following references are cited to further show the state of the art with respect methods of automatically filling electronic documents: Kramer et al, Mohan et al, and Davis et al.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Kyle whose telephone number is 703-305-3614. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

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16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on 703-308-3179. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

17. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

mk



Anthony Knight
Supervisory Patent Examiner
Technology Center 3600